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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/810,347

Filing Date: March 26, 2004

Appellant(s): PULLARO, TERRY

Brian J. Gill
Polster, Lieder, Woodruff, & Lucchesi, L.C.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/15/2008 appealing from the Office action mailed 4/11/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

In Application No. 09/598110, Appeal No. 2004-0148 wherein the decision is dated 2/26/2004. The above application is commonly owned by the party of interest.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 07/24/2007 had been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

D241958	Smith	10-1976
5215307	Huffman	06-1993
4378113	Piccini	03-1983
4272007	Spivey	06-1981
6379261	Hart	04-2002

MPEP 2143 "Examples of Basic Requirement of Prima Facie Obviousness" pp. 128-139.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN D241958)in view of Huffman (USPN 5215307) and Piccini (USPN 4378113) further in view of Spivey (USPN 4272077).

Regarding claims 1 and 10-14, Smith discloses a weight exercise device comprising a handle shaped like a grip portion of a sport implement having a first and second ends and a weight positioned at the second end of the handle (See Entire Document). Koszalinski does not disclose the length of the device, the size of the handle, or how the weight is attached to the handle. Huffman discloses an exercise

device for strengthening muscles comprising a handle and a weight at the end of the handles wherein the device is of a length of 15 to 30 inches (See Summary of the Invention). Huffman also notes that the weights on the ends of the handle may be offset such that one end of the handle weighs more than the other end of the handle. Such effect would move the location of the center of gravity anywhere from the center of the device to the ends of the device. One having ordinary skill in the art would have found it obvious to have the device of the above lengths, especially 15 inches, in order to vary the location of the center of gravity of the device. Huffman notes that the grips of a particular sport implement may be used such as in golf, baseball, tennis, etc. If in doubt, Piccini discloses a device for conditioning the forearms wherein the device comprises a handle and a weighted end and is approximately the length of a human forearm (14 inches). One having ordinary skill in the art would have found it obvious to have the device of Smith to be about 14 inches, as taught by Piccini in order to condition the forearms. Spivey discloses a handle for a golf club in which the handle is about 30% larger than a standard golf grip (See Figure 5). One having ordinary skill in the art would have found it obvious to increase the size of the grip in order to improve jerks or yipes, or in other words, improve the gripping of the implement. It should be noted that the devices of Huffman and Piccini all can be used to condition the forearms for various sports.

Regarding claim 6, Huffman notes that the device has a length of 15 to 30 inches and also notes that the length of the weights may vary. One having ordinary skill in the art would have found it obvious to have any length for the handle and weight so long as

the device strengthens the arm. Further Piccini discloses the device being 14 inches wherein it is shown that the handle only accounts for about 1/3 of the entire length of the device. One having ordinary skill in the art would have found it obvious to have any length for the handle and weight so long as the device strengthens the arm

Regarding claim 7, Huffman implies that the device weighs more than the hand-held implement used in the sport (See Background of the invention).

Regarding claims 8 and 9, Huffman discloses the handles having an externally thread portion and the weight having an internally thread socket (See Figure 10).

Claims 4 and 5 rejected under 35 U.S.C. 103(a)as being unpatentable over the prior art applied in claim 1 above in view of Hart (USPN 6379261).

Regarding claims 4 and 5, the prior art applied to claim 1 above does not disclose the size of the weight. Hart discloses a swing trainer having a handle and weight wherein the weight has a length of 1.5 to 4 inches and a diameter of 1.25 in (See Column 10, lines 30 through 39). Hart notes that the device is of an adequate size to be used indoors or outdoors. One having ordinary skill in the art would have found it obvious to have the weight of the prior art, applied to claim 1, to be less than 4 inches in length and diameter, as taught by Hart, in order to give the device an adequate size to be used indoors or outdoors.

(10) Response to Argument

The appellant argues ultimately that the above rejection has been furnished via hindsight in which the references have the following issues:

- A. Smith does not have any disclosure and cannot be used as a primary reference because it does not suggest a conditioning device;
- B. Huffman teaches away from Smith;
- C. Piccini teaches a device having variable weight and does condition the forearms; and
- D. Spivey has no nexus to any of the above references.

The examiner disagrees with all of the above issues presented by the appellant.

KSR in connection with Graham v. Deere notes that an articulated rationale is necessary to come to a conclusion of obviousness. Also drawn from KSR are examples of rationale that may be used to support a conclusion of obviousness. Some are 1) Combining prior art element of according to known methods to produce a predictable result, 2) Simple substitution of one known element for another to obtain a predictable result, 3) Use known techniques to improve similar devices in the same way, 4) Applying a known technique to a known device ready for improvement to yield predictable results, 5) Obvious to try, 6) Known work in one field of endeavor that may prompt variations of it for its use in either the same field or a different one based on design incentives or other market forces if the variation is predictable to one of ordinary skill in the art, and 7) Teaching, suggestion, and motivation (TSM). The appellant has submitted a memorandum issued by the USPTO dated 3/7/2007 in an attempt to strengthen an argument of alleged hindsight. The only thing that the memorandum states is that the rationale should be made explicit and that the TSM is a factor in determining a conclusion of obviousness. With this noted, the combination of the

references will be shown to teach, suggest, and give motivation as to why the instant invention is obvious.

Before explanation of the prior art, It should be noted that all arguments pertain to claim 1 and not other claims. It should be noted that Appellant does not give any description as to what a grip of a sport implement should structurally be. Thus a grip of a sport implement can be any used for grasping. It should also be noted that a sport implement is a very broad and can comprise of anything.

A. Regarding the Smith reference, MPEP 2123 notes that patents are relevant for all that they contain. As noted in the rejection Smith discloses a golf practice device having a handle and a weight at one end wherein the handle is shaped like the grip of a sport implement. It is noted that the Smith is entitled “Golf Swing Practice Club,” which would indicate that the device is used for practicing or preparing for golf. Appellant has provided no reason to believe that practicing and conditioning are two different regimes. Practice and conditioning both allows one to engage in repetitive acts in order to be prepared for a situation. In addition, rational need not be the same to come to a conclusion of obviousness.

B. Regarding Huffman, Huffman teaches away from the use of weight clubs wherein the weight is attached to the end of a golf club shaft not a handle. Placing the weight farther from the user would increase inertia which is why the weight would tend to pull the user toward the weight similar to the hammers thrown in the Olympics. Because of this, the center of gravity is farther away from the user. So in order to reduce the inertia created by the device, Huffman places a counterweight on the end of

the handle to move the center of gravity closer to the user, which is the primary objective of Huffman. The examiner's use of Huffman shows motivation as to why the center of gravity should be closer to the user, specifically less than 13 inches from the end of the handle. It allows the user to practice specific swings and exercises without losing control of the device. Huffman also notes that the handle can be shaped like the grips in a number of sports such as tennis, golf, and baseball. It should be recalled that Smith teaches a "Golf Swing Practice Club" and that the applicant has not made any distinction between practice and conditioning. Based on the teachings of Huffman, one would find it obvious to make the specific gravity closer to the user, especially, less than 13 inches from the end of the handle.

C. Regarding Piccini, Piccini discloses a device wherein the weight can be varied for strengthen the wrist. However, the appellant does not mention that the twisting the wrist also inherently requires the use of the forearm muscles which would occur while twisting the wrists. Thus, Piccini inherently teaches warming-up the forearms. Piccini also notes that the device is about the length of a forearm which is about 14 inches. Also, it is noted above that the weight of the device is variable. This implies that the center of gravity of the device is less than 13 inches from the end of the handle. Piccini is constructed to have a larger size as it approaches the distal end and the proximate end being the smallest. This specifically allows the center of gravity to be place farther from the user but not so far that the user cannot control the device. Appellant argues that Piccini teaches away from the user not grasping the handle as used in the sport. It is believed that the appellant interpreted Piccini as modifying Huffman; however, Piccini

is not used to modify Huffman. The rejection states “Smith in view of Huffman and Piccini further in view of Spivey.” Piccini was added to further show the effects of moving the center of gravity close to the user. Further Piccini makes reference in the Summary of the Invention that the device may be used to warm-up for golf. It should also be noted that Smith does not disclose how the handle is to be grasped.

D. Regarding Spivey, Spivey discloses a putter grip for preventing yipes and notes in the Background and Object of the invention that the grip also keeps the non-dominant hand in its most relaxed state. In other words, having the non-dominant hand in the most relaxed states improves the gripping of the implement for the user. Smith, Huffman both discloses the device having a handle for gripping. Incorporating the grip of Spivey into that of Smith and Huffman would not change the improvements that the Spivey notes the enlarged grip possesses. Appellant argues that Spivey is not concerned with the issues overcome by the applicant’s device. MPEP 2144 notes that the rationale may be different from that of the applicant’s. In addition to improving the grip of the user, the grip also prevents yipes and jerks when putting. Smith and Huffman are both devices for practicing golf therefore adding the grip of Spivey to Smith and Huffman would also train the user to minimize yipes and jerks.

It should be noted that the appellant makes no argument with respect to the Hart reference applied to claims 4 and 5. Therefore, argument with respect to claims 4 and 5 are considered moot.

As shown above, all references have a nexus and reason for TSM contrary to the appellant’s arguments to the use of hindsight.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Alvin A Hunter/

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